



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,034	09/16/1999	HIROYUKI ATAKE	DAIN:435A	8263

7590

07/08/2002

PARKHURST & WENDELL LLP
1421 PRINCE STREET SUITE 210
ALEXANDRIA, VA 223142805

EXAMINER

JACKSON, MONIQUE R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 07/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/397,034	Applicant(s) ATAKE, HIROYUKI	
	Examiner Moniqu R Jackson	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13,14,16-18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13,14,16-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/957,068.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The request filed on 4/11/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/397034 is acceptable and a CPA has been established. An action on the CPA follows.
2. The amendment filed 4/11/02 has been entered. Claims 15 and 19 have been canceled. Claims 13, 14, 16-18 and 20-22 are pending in the application.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Applicant is advised that should claims 14 and/or 18 be found allowable, claims 16 and/or 20, respectively, will be objected to under 37 CFR 1.75 as being substantial duplicates thereof, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 13-14, 16-17 and 21-22 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 07-286192 A (JP' 192.) JP' 192 teaches a coating excellent in film forming properties

Art Unit: 1773

wherein the coating comprises a polymer obtained by polymerizing 5-500wt parts of a monomer component consisting essentially of (meth)acrylate such as methyl methacrylate, selected so that the Tg of the polymer is greater than -20°C, preferably 0-120°C, and in the presence of 100 wt parts of polyorganosiloxane polymer particles, wherein the film formed after drying of the dispersion has a coefficient of kinetic friction of less than 0.4. JP'192 teaches that the coating can be applied to a variety of base materials including polymer films (*molded polymer article or backing sheet*) such as PET films as in the examples or paper such as in the manufacture of wallpaper (*decorative laminate*.) JP'192 also teaches that the monomer component, glass transition point and the amount of additive affect the dynamic friction coefficient (*coefficient of kinetic friction*) to give outstanding detachability and slide nature and are suitably chosen such that the coefficient of kinetic friction can be 0.05-0.2, still preferably 0.3 or less, more preferably 0.4 or less (0044-0045.)

7. Claims 13-14, 16-17 and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al (USPN 5,302,459.) Kim et al teach a method for the preparation of polyester films with good release and slip (*low friction*) properties comprising coating on the surface of an extruded polyester film (*molded polymer article or backing sheet*), an acrylic resin-based aqueous resin compound, such as a polymer of alkyl acrylate/alkyl methacrylate as in Examples 1-2, with the alkyl groups selected from those listed at..including methyl and n-butyl, with a glass transition temperature Tg of more than 40°C, wherein the Tg of Examples 1-2 was 50°C and the coefficient of kinetic friction was 0.23 and 0.36, respectively.

Claim Rejections - 35 USC § 103

8. Claims 13-14, 16-18 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatebayashi (USPN 4,386,042) in view of JP' 192. Tatebayashi teaches a molded product and a method of providing a desired surface-hardness for its surface comprising the steps of cutting a thermoplastic film such as a PET film to the same form as the exterior form of the product, placing the cut piece on a mold-cavity surface, and injecting a molten resin for formation of the product into the mold cavity wherein, in advance, the thermoplastic film is subjected to a hard-coating treatment such as treatment with an acrylic resin coating to thereby form a hard-coating layer on the surface of the product (hence the polyester film is a backing film positioned between the acrylic resin layer and the molded product, specifically as in instant claims 18 and 20; Abstract; Col. 4, lines 36-39 and lines 45-48.) Tatebayashi does not teach that the acrylic surface coating consists essentially of the polymer listed in instant claims 13, 17 and 21 and having a T_g and a coefficient of kinetic friction as instantly claimed, however, it would have been obvious to one having ordinary skill in the art to utilize any acrylic surface coating wherein JP' 192 teaches an acrylic coating excellent in film forming properties, outstanding detachability, slip properties and slide nature, wherein the coating comprises a polymer obtained by polymerizing 5-500wt parts of a monomer component consisting essentially of (meth)acrylate such as methyl methacrylate, selected so that the T_g of the polymer is greater than -20°C, preferably 0-120°C, and in the presence of 100 wt parts of polyorganosiloxane polymer particles, wherein the film formed after drying of the dispersion has a coefficient of kinetic friction of less than 0.4. JP' 192 teaches that the coating can be applied to a variety of base materials including polymer films (*molded polymer article or polymer backing*) such as PET films as in the

Art Unit: 1773

examples or paper such as in the manufacture of wallpaper (*decorative laminate*.) JP' 192 also teaches that the monomer component, glass transition point and the amount of additive affect the dynamic friction coefficient (*coefficient of kinetic friction*) to give outstanding detachability and slide nature and are suitably chosen such that the coefficient of kinetic friction can be 0.05-0.2, still preferably 0.3 or less, more preferably 0.4 or less (0044-0045.) Hence, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize the acrylic surface coating taught by JP' 192 for the acrylic coating of the invention taught by Tatebayashi given its excellent properties wherein it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize routine experimentation to determine the optimum monomer components, glass transition point and amount of additive to provide the desired releaseability and slip or slide properties for a particular end use.

Response to Arguments

9. Applicant's arguments with respect to claims 13, 14, 16-18 and 20-22 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Application/Control Number: 09/397,034

Page 6

Art Unit: 1773

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read 'Monique R. Jackson', with a stylized, cursive script.

Monique R. Jackson
Patent Examiner
Technology Center 1700
July 1, 2002